

**REMARKS**

In the final Office Action mailed July 22, 2008<sup>1</sup>, the Examiner rejected claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50-52 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2003/0112928 to Brown et al. ("*Brown*") in view of U.S. Patent No. 5,535,265 to Suwandhupatra ("*Suwandhupatra*") and further in view of U.S. Patent No. 6,996,227 to Albal et al. ("*Albal*"); and rejected claims 7 and 49 under 35 U.S.C § 103(a) as unpatentable over *Brown*, *Suwandhupatra*, and *Albal*, and further in view of U.S. Patent Publication No. 2003/0069874 to Hertzog et al. ("*Hertzog*").

**I. The Finality of the Office Action is Improper**

**A. The Final Office Action fails to address every recitation of the independent claims**

The final Office Action does not comply with 37 C.F.R. § 1.104(c). 37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the recitations of a rejected claim. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2) (emphasis added).

In the final Office Action, independent claim 18 is rejected for the same reasons as claim 1 (final Office Action at p. 2). However, claim 18 includes a number of

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

recitations not included in claim 1. For example, claim 18 recites "filter settings being specific to each of the plurality of source communication devices," while claim 1 contains no corresponding recitation. Similar deficiencies exist with respect to independent claim 47.

Because the final Office Action has not addressed each and every recitation of all the independent claims, the final Office Action does not comply with 37 C.F.R. § 1.104(c). Accordingly, should the rejections be maintained, Applicants respectfully request a new non-final Office Action addressing each and every recitation of all of the claims, including independent claims 18 and 47.

**B. The Final Office Action Fails to Answer the Substance of Applicants' Arguments**

The final Office Action does not comply with MPEP § 707.07(f). MPEP § 707.07(f) states, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

In the Reply to Office Action filed April 14, 2008, Applicants traversed the rejection of independent claim 18, noting that *Brown* and *Albal* fail to teach or suggest at least the claimed "filter settings being specific to each of the plurality of source communication devices" (Reply at pp. 16-17). The final Office Action includes a "Response to Arguments" section that does not address Applicants arguments, merely stating that the arguments are "moot in view of the new grounds of rejection" (final Office Action at p. 11). However, the final Office Action does not refer to the new reference, *Suwandhupatra*, or any of the previous references in rejecting claim 18.

Thus, the final Office Action has failed to address Applicants' position regarding claim 18 as presented in the Reply.

As the final Office Action does not address the reasoning presented in the Reply, the final Office Action does not comply with MPEP § 707.07(f). Accordingly, should the rejections be maintained, Applicants respectfully request a new non-final Office Action addressing Applicants' position as articulated in the Reply.

**II. The Rejection of Claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50-52 under 35 U.S.C. § 103(a)**

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Applicants respectfully traverse the rejection of claims 1-6, 8-11, 13-22, 24-35, 37-47, and 50-52 under 35 U.S.C. § 103(a) for at least the following reasons.

**A. Claims 1-6, 8-11, 13-17, 27-35, 37-46, 50, and 51**

Claim 1 recites a method for logging calls comprising "receiving instructions that . . . specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log" (emphasis added).

The final Office Action concedes that *Brown* fails to disclose this recitation of claim 1 (Final Office Action at p. 3). *Suwandhupatra* discloses a telephone line monitoring circuit for a MODEM that performs a variety of functions, including call logging of local phones (*Suwandhupatra*, abstract). *Suwandhupatra* uses a call logging/call blocking application that maintains a record of outgoing calls in a computer

memory (*Suwandhupatra*, col. 7, lines 21-23). The application records telephone numbers from local phones, as well as the times and durations of calls (*Suwandhupatra*, col. 7, lines 23-26)

*Suwandhupatra*'s modem can be set to block outgoing calls to pre-specified numbers (*Suwandhupatra*, col. 7, lines 26-28). The Examiner relies on this teaching of *Suwandhupatra* in addressing the claimed "phone calls to the specified number are to be excluded from the phone log." (final Office Action at p. 3). In relying on this teaching of *Suwandhupatra*, the final Office Action states that "if outgoing calls are blocked to a specified phone number, that number is 'excluded' from a call log, due to the fact that the call is never made in order for it to be logged." (final Office Action at p. 3).

This is incorrect. *Suwandhupatra* records the dialed number (*Suwandhupatra*, FIG. 3, ref. 322) time and date (*Suwandhupatra*, FIG. 3, ref. 326) of each outgoing phone call before determining whether the dialed number matches any blocked numbers at step 330. Thus, even if the dialed outgoing number is blocked and the call is not made, *Suwandhupatra* logs the call. Therefore, *Suwandhupatra* does not teach or suggest "receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log," as recited by independent claim 1.

*Albal* fails to cure the deficiencies of *Brown* and *Suwandhupatra*. *Albal* discloses storing information in an address book by creating records of telephone calls, and determining if the records match telephone numbers in the address book (*Albal*, abstract). However, while the user can update or change the content in the address book (*Albal*, col. 4, lines 25-27), *Albal* does not disclose or suggest that whether or not

the records are stored is based on whether the calls were to a specified phone number. Therefore, *Albal* also fails to disclose or render obvious the claimed “receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log” as recited by independent claim 1.

Although of different scope, independent claims 27 and 46 are distinguishable over *Brown*, *Suwandhupatra*, and *Albal* for reasons similar to those discussed above with respect to claim 1. Because the cited references fail to disclose or render obvious the subject matter recited by independent claims 1, 27, and 46, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 2-6, 8-11, 13-17, 50, and 51 depend from claim 1, and claims 28-35 and 37-45 depend from claim 27, and these dependent claims are allowable not only for the reasons stated above with regard to their respective allowable base claims, but also for their own additional features that distinguish them from the cited art.

**B. Claims 18-22, 24-26, 47, and 52**

Independent claim 18 recites a method for logging calls comprising “receiving instructions that specify filter settings for logging information associated with the outgoing calls ... the filter settings being specific to each of the plurality of source communication devices associated with the user” (emphasis added).

*Brown* discloses a method, system, and program for logging calls according to a call context (*Brown*, abstract), and entities can specify “logging preferences” related to call context (*Brown*, ¶ 155). However, while *Brown* indicates the call context can

include device identities (*Brown*, ¶ 39) *Brown* does not disclose or suggest device-specific logging preferences. Therefore, *Brown* fails to render obvious the claimed "receiving instructions that specify filter settings for logging information associated with the outgoing calls ... the filter settings being specific to each of the plurality of source communication devices associated with the user," (emphasis added) as recited by independent claim 18.

*Suwandhupatra* fails to cure the deficiencies of *Brown*. As discussed, *Suwandhupatra* discloses a telephone line monitoring circuit for a MODEM that performs a variety of functions, including call logging of local phones (*Suwandhupatra*, abstract). Further, as discussed, *Suwandhupatra* discloses using a modem to block phone calls to specified numbers (*Suwandhupatra*, col. 7, lines 25-27). However, as also discussed, *Suwandhupatra*'s outgoing calls are logged regardless of whether they are blocked. Therefore, *Suwandhupatra* fails to disclose or render obvious the claimed "receiving instructions that specify filter settings for logging information associated with the outgoing calls ... the filter settings being specific to each of the plurality of source communication devices associated with the user," (emphasis added) as recited by independent claim 18.

*Albal* fails to cure the above-discussed deficiencies of *Brown* and *Suwandhupatra*. As previously discussed, *Albal* discloses storing information in an address book by creating records of telephone calls, and determining if the records match telephone numbers in the address book (*Albal*, abstract). However, while the user can update or change the content in the address book (*Albal*, col. 4, lines 25-27), *Albal* does not disclose or suggest that the records are stored based on device-specific

filter settings. Therefore, *Albal* fails to disclose or render obvious the claimed "receiving ... instructions for excluding at least one outgoing call from a call log, the filter settings being specific to each of a plurality of devices associated with a user" as recited by independent claim 18 (emphasis added).

Although of different scope, independent claim 47 is distinguishable over the cited art for reasons similar to those discussed above with respect to claim 18. Because the cited references fail to disclose or render obvious the subject matter recited by claims 18 and 47, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 19-22, 24-26, and 52 depend from claim 18, and are allowable not only for the reasons stated above with regard to their respective allowable base claim, but also for their own additional features that distinguish them from the cited art.

### **III. The Rejection of Claims 7 and 49 under 35 U.S.C § 103(a)**

Claim 7 and 49 depend from claim 1, and therefore include all of the elements recited therein. As already discussed, *Brown*, *Suwandhupatra*, and *Albal* fail to disclose or render obvious "receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log."

*Hertzog* fails to cure the deficiencies of *Brown*, *Suwandhupatra*, and *Albal*. *Hertzog* discloses a database of personal contact information that allows a user to dictate preferences for when their associated contact information is valid (*Hertzog*, abstract). However, *Hertzog* does not disclose or suggest allowing a user to specify a number, where phone calls to the specified number are excluded from a call log.



Therefore, *Hertzog* also does not disclose or render obvious "receiving instructions that ... specify a phone number, wherein phone calls to the specified phone number are to be excluded from a call log."

Because the cited references fail to disclose or render obvious the subject matter of claims 7 and 49, no prima facie case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of these claims under 35 U.S.C. § 103(a).


**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Reply, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:   
Philip J. Hoffmann  
Reg. No. 46,340